

REMARKS

In the Office Action, claims 1, 2, 5-8, 12-14, 16, 21, 22, 27, 29-31, and 38-45 are rejected under 35 U.S.C. §102(e) as being anticipated by Dedrick ("Dedrick"), (US Patent No. 5,710,884).

In the Office Action, claims 3, 4, 9-11, 17-20, 23-26, 28, 32-37, and 46-57 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dedrick (US Patent No. 5,710,884).

In response thereto, claims 1, 7, 8, 14 and 16 have been cancelled and claims 2, 3, 5, 6, 9, 11-13, 17, 19-22, 27, 29, 30, 35, 38-48, 50, 52, 54, and 56 have been amended. Accordingly, claims 2-6, 9-13, and 17-57 are now pending. Following is a discussion of the patentability of each of the pending claims.

Independent Claims 3, 9, and 17

Claims 3, 9, and 17 describe a system or method in which a target computer receives a content and a content provider is coupled to the target computer via a network to transmit the content. The content provider has a user rule page containing information obtained from the target computer by a first agent. A rule book provides a rule based on the user rule page, and the rule controls the content to be transmitted from a database to the target computer. The rule is stored in the form of a condition-action pair. The condition in the condition-action pair is a hardware characteristic of the target computer.

It is apparently conceded that the Dedrick reference does not disclose or suggest a rule being stored in the form of a condition-action pair in which a condition in the condition-action pair is a hardware characteristic of the target computer. For this reason, it appears the Examiner has stated that artisans of ordinary skill in the art have long known that it is common to collect data regarding a computer user's hardware and software in order to gather information. It is respectfully submitted that any rejection of claims 3, 9, and 17 based on a

combination of these references, however, would be improper. “Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so.” *In re Jones*, 21 USPQ 2d 1941 (Fed. Cir. 1992). In this connection, the Office Action fails to point to anything in the references that would suggest the apparent proposed reconstruction to pick and chose among the isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992). As there is no suggestion in the references for the proposed combination, any rejection of claims 3, 9, and 17 would fail to present a prima facie case of obviousness.

Furthermore, it is well established patent law that discovery of a problem and the conception of a solution should all be considered relative to the “subject matter as a whole” in accordance with 25 U.S.C. Section 103. *Hobbes v. Beach*, 180 U.S. 383, 393 (1901); *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 45 (1923); *In re Worrest*, 96 U.S.P.Q. 381 (C.C.P.A., 1953); *In re Osplack*, 93 U.S.P.Q. 306 (C.C.P.A., 1952); *In re Bisley*, 94 U.S.P.Q. 80 (C.C.P.A. 1952); and *In re Wright*, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988). In the present application, the inventor has discerned a problem, namely that the bandwidth of transmissions media are limited and the increasing expense of placing an advertisement in highly visible area of the Internet. It is in response to this discerned problem that Applicant has developed a practical solution which is not suggested by the prior art. In particular, the problem has been solved by targeting specific audiences rather than transmitting numerous broadcasts to all consumers. As such, claims 3, 9, and 17 recite a system and method to customize and target advertisements to particular audiences more likely to be interested in the particular advertisement or to which the advertising particularly pertains.

The present invention is not merely to be judged by the fact that some of the prior art references have incidental disclosures which show one or more features or another of

Applicant's claimed invention. To the contrary, the invention should be gauged by the overall concept of the invention as claimed, which includes a monitoring circuit to save power. All of the factors recited in claims 3, 9, and 17 pertain to the present invention, and there is no teaching of this invention in any of the references either taken alone or in combination. Accordingly, it is respectfully submitted that these claims are in condition for allowance.

Dependent Claims

Claims 2, 4-6, 24-26, 28, 29, 41, 43, and 48 depend from claim 3, claims 10-13, 30, 31, and 33-35 depend from claim 9, and claims 18-20, 22, 23, 27, 32, 36, 40, 42, 45, and 54-57 depend from claim 17. As such, these claims are similarly patentable. It is respectfully submitted that these claims are in condition for allowance.

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1 1. (Cancelled)

1 2. (Four Times Amended) The system of claim [1] 3 wherein the rule is stored in
2 form of a condition-action pair.

1 3. (Five Times Amended) [The system of claim 2] A system comprising:
2 a target computer to receive a content; and
3 a content provider coupled to the target computer via a network to transmit the
4 content, the content provider comprising:
5 a user rule page containing information obtained from the target computer by
6 a first agent; and
7 a rulebook to provide a rule based on the user rule page, the rule controlling
8 the content to be transmitted from a database to the target computer, the rule stored in
9 form of a condition-action pair, [wherein] a condition in the condition-action pair [is]
10 being a hardware characteristic of the target computer.

1 5. (Four Times Amended) The system of claim [1] 3 wherein the first agent uses
2 an internet programming language.

1 6. (Four Times Amended) The system of claim [1] 3 wherein the rule page
2 comprises at least one of a hardware profile indicating hardware capabilities of the target
3 computer, a software profile indicating software used by the target computer, and a user
4 profile including dynamic information related to a user using the target computer.

1 7. (Cancelled)

1 8. (Cancelled)

1 9. (Four Times Amended) [The method of claim 8] A method comprising:

2 obtaining information from a target computer by a first agent, the information being
3 stored in a user rule page;

4 providing a rule based on the rule page by a rule book, the rule controlling a content
5 from a database; [and]

6 transmitting through a network the content from the database to the target computer;
7 and

8 storing the rule in form of a condition-action pair, [wherein] a condition in the
9 condition-action pairs [is] being a hardware characteristic of the target computer.

1 11. (Two Times Amended) The method of claim [7] 9 wherein the rule page
2 comprises at least one of a hardware profile to indicate hardware capabilities of the target
3 computer and a software profile to indicate software used by the target computer.

1 12. (Two Times Amended) The method of claim [7] 9 wherein the content is
2 transmitted in an internet protocol format.

1 13. (Three Times Amended) The method of claim [7] 9 wherein the rule page
2 comprises a user profile including dynamic information related to a user using the target
3 computer.

1 14. (Cancelled)

1 16. (Cancelled)

1 17. (Three Times Amended) [The system of claim 16] A system comprising:
2 a content provider transmitting a content via a network to a target computer, the
3 content provider comprising:
4 a user rule page containing information being obtained from the target
5 computer by a first agent; and
6 a rulebook to provide a rule based on the user rule page, the rule controlling a
7 content transmitted from a database to the target computer, the rule being stored in
8 form of a condition-action pair, [wherein] a condition in the condition-action pair [is]
9 being a hardware characteristic of the target computer.

1 19. (Four Times Amended) The system of claim [14] 17 wherein the rule page
2 comprises a hardware profile to indicate hardware capabilities of the target computer.

1 20. (Four Times Amended) The system of claim [14] 17 wherein the rule page
2 comprises a software profile to indicate software used by the target computer.

1 21. (Three Times Amended) The system of claim [1] 3 further comprising a
2 second agent to update information in the user rule page rule directs the content in a database
3 and provides a rule page corresponding to the target computer.

1 22. (Four Times Amended) The system of claim [14] 17 wherein the content is
2 transmitted in an internet protocol format.

1 27. (Three Times Amended) The system of claim [14] 17 wherein the rule page
2 comprises a user profile including dynamic information related to a user using the target
3 computer.

1 29. (Two Times Amended) The system of claim [1] 3 wherein the content is an
2 advertisement banner.

1 30. (Two Times Amended) The method of claim [7] 9 further comprising:
2 updating the information in the rule page.

1 35. (Two Times Amended) The method of claim [7] 9 wherein the dynamic
2 information comprises information on web sites visited and time spent by the target
3 computer.

1 38. (Amended) The method of claim [7] 9 wherein the content is an advertisement
2 banner.

1 39. (Two Times Amended) The method of claim [7] 9 wherein the first agent uses
2 an internet programming language.

1 40. (Three Times Amended) The system of claim [14] 17 wherein the first agent
2 uses an internet programming language.

1 41. (Amended) The system of claim [1] 3 wherein the content is transmitted in an
2 internet protocol format.

1 42. (Two Times Amended) The system of claim [14] 17 further comprising a
2 second agent to update information in the rule page.

1 43. (Two Times Amended) The system of claim [1] 3 further comprising a second
2 agent to update information in the rule page.

1 44. (Amended) The method of claim [7] 9 wherein the content is an ad banner.

1 45. (Two Times Amended) The system of claim [14] 17 wherein the content is an
2 ad banner.

1 46. (Amended) The system of claim [1] 3 wherein the first agent is an object code
2 for a control residing on a web page.

1 47. (Amended) The system of claim [47] 46 wherein the control is transmitted
2 with the web page while a dormant object code resides on a server.

1 48. (Amended) The system of claim [1] 3 wherein the target computer
2 communicates with additional content providers, and wherein the target computer maintains
3 several provider rule pages of the additional content providers.

1 50. (Amended) The method of claim [7] 9 wherein the first agent is an object code
2 for a control residing on a web page.

1 52. (Amended) The method of claim [7] 9 further comprising:

2 communicating the target computer with additional content providers, the target
3 computer maintaining several provider rule pages of the additional content providers.

1 54. (Amended) The system of claim [14] 17 wherein the first agent is an object
2 code for a control residing on a web page.

1 56. (Amended) The system of claim [14] 17 wherein the target computer
2 communicates with additional content providers, and wherein the target computer maintains
3 several provider rule pages of the additional content providers.

CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that all pending claims are in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: January 14, 2002

Ronald S. Tamura

RONALD S. TAMURA

Reg. No. 43,179

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025
(714) 557-3800

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on: January 14, 2002.

Laura Robles 1/14/02
Laura Robles Date